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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/218,335	12/22/1998	KYOJI OMI	0557-4442-2R	3249
22850	7590	04/02/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			GRANT II, JEROME	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/218,335	<b>Applicant(s)</b> OMI, KYOJI	
	<b>Examiner</b> Jerome Grant II	<b>Art Unit</b> 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11, 48 and 49 is/are allowed.
- 6) ☒ Claim(s) 12-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**JEROME GRANT II**  
**PRIMARY EXAMINER**

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

## Detailed Action

1. The final rejection mailed May 27, 2003 is withdrawn for reasons that new art has been found and a rejection under the most recent case law Ex Parte Eggert (copy <sup>67 USPQ 2d 1716</sup> provided herein, believed to be unpublished).

2. Claims 12-27 are rejected under 35 U.S.C. Sect. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for patent (08/215,608) upon which the present case is based.

From the results of In re Clement, the court derived the following principles:

1) if the reissue claim is as broad as or broader than the canceled or amended claim [the surrendered subject matter in all aspects, the recapture rule bars the claim; 2) if it is narrower [than the surrendered subject matter] in all aspects, the recapture rule does not apply, but other rejections are possible; 3) if the reissue claim is broader [than the surrendered subject matter] in others, then: a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; b) if the reissue claim is narrower in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

Art Unit: 2626

Hence, the example that we have before us is 3a. In parent case 08/215,608, the surrendered subject matter according to claim 4 was the apparatus comprised of the scanner module and the printer module each having a means to power said modules and each having separate housing or framing from each other. The subject matter which was amended and which placed the application in condition for allowance was the first, second and third interface devices as claimed and the system control module according to claim 4.

Claims 12 and 30 do not recite the first, second or third interfaces as recited in claim 1 of the original patent, nor is the system control module recited as provided in claim 4 of the original patent. The system control module was responsible for receiving power from the scanning and printing modules.

Therefore, according to part 3a of the rule, the reissue claims 12 and 30 are broader in that they do not include the first, second and third interface means as well as the system control module as recited in claim 4 of the original patent. Moreover, the reissue claims are narrower in an aspect completely unrelated to the rejection. For example, the conditions of claims 12 and 30 recite that a printer has an input and an output and that the output of the printer is connected to the input of the scanner and that the scanner and printer are stacked on top of each other. This claimed subject matter while narrowing does so in an aspect completely unrelated to the rejection. Note, there is no argument or amendments directed toward the power supply aspect of either the

Art Unit: 2626

scanner module or the printer module (see claim 4 of the original patent). Therefore, the examiner concludes that the narrowing limitation regarding the power supply of the scanner and printer modules is narrowing of claimed limitations in an aspect unrelated to the rejection of 3-19-1996 [ applicant's remarks or amendments] in the parent case.

3.

#### Art Rejections

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 13, 21-24, 26, 27, 29-31, 39, 41-45 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiromichi.

Art Unit: 2626

With respect to claim 12, Hiromichi JP04068862 (862) teaches an image forming system (shown by figure 1), comprising: a printer module 3, including: a printer engine (laser 3b, drum toner , etc shown by figure 3); a printer controller 3a connected to the printer engine; a power supply 4 having two outputs and an input from a wall unit inherent but not illustrated; and a first frame (shown by figure 1 as identified by the examiner) ; a scanner module 2, including a scanner engine 2c; a scanner controller 2a connected to the scanner engine, see top portion of figure 1; a power input (connected from power source 4 to lower portion of member 2a as shown by the top portion of figure 2) for connection to the output of the power supply of the printer; a second frame 2 different from the first frame 3 and a user interface (computer 1) connected to the scanner module 2 and the printer module 3 wherein the printer and scanner are stacked one on the other (see figure 1 which clearly shows this limitation).

With respect to claim 13, see figure 1.

With respect to claim 21, the user interface is computer 1 and the printer module is shown to be incorporated with it according to figure 1.

With respect to claim 22, the user interface (computer 1) includes a display which displays a state of the printer module and the scanner module.

With respect to claim 23, Hiromichi teaches minimal cables that are represented by bi-directional arrows to and from the computer 1 and devices (2,3).

With respect to claim 24, Hiromichi shows the cable connections as claimed. For example, cables represented by the dark bold lines of figure 1 show connections between the printer module and the scanner module.

With respect to claim 26, Hiromichi teaches the first and second frames as clearly shown by figure 1.

With respect to claim 27, Hiromichi teaches first and second separate structures, as shown by figure 1.

With respect to claim 29, commercial power is inherent in its utilization for the functionality of the modules 2 and 3.

With respect to claim 30, Hiromichi teaches an image forming system, comprising: a printer module 3, including: means (laser 3b, polygonal mirror and drum) for generating a printed image on a piece of paper; print control means 3a, connected to the means for generating, for controlling an operation of generating the printed image; means (4) for supplying power 1 having an input means (receiving power from a wall unit) for inputting and an output means (2) for outputting power to the scanner and the other output means leading to the printer; first means (frame which is an inherent structure shown by lower half of figure 1) for supporting elements as claimed; a scanner module 2, including: means 2c for scanning an image; a scanner control means 2a which controls an operation of the scan; a power input means (4) for inputting power to the scanner module (2) from the means for supplying power of the print module (power

Art Unit: 2626

source 4 is in the print module 3) and for connection to the output means of the power supply of the printer module, see the connections and the power source shown in figure 1. Hiromichi further teaches second means (frame structure) for supporting elements of the scanner module (this is inherently shown by upper half of figure 1) for the purpose as claimed. Hiromichi teaches interface means (computer 1) which is connected to the printer and the scanner modules wherein the printer module 3 and the scanner module 2 are stacked upon each other, see figure 1.

With respect to claim 31, computer 1 is the means for interfacing the scanner module 2.

With respect to claim 39, computer 1 is the means for interfacing and is incorporated in the printer module.

With respect to claim 41, Hiromichi teaches minimal cables that are represented by bi-directional arrows to and from the computer 1 and devices (2,3).

With respect to claim 42, Hiromichi shows the cable connections as claimed. For example, cables represented by the dark bold lines of figure 1 show connections between the printer module and the scanner module.

With respect to claims 43, Fukushima teaches a display 100 which comprises a bit map display from the bit map stored in video memory 101. Claim 43 is rejected for all the reasons that claim 30 is rejected in addition to the bit map display feature that



Art Unit: 2626

would have been recognized to be incorporated in computer 1 of Hiromichi as suggested by Fukushima.

With respect to claim 44, Hiromichi teaches the first and second frames as clearly shown by figure 1.

With respect to claim 45, Hiromichi teaches first and second separate structures, as shown by figure 1.

With respect to claim 47, commercial power is inherent in its utilization for the functionality of the modules 2 and 3.

4.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-20, 25, 28, 32-38, 40 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiromichi in view of Fukushima.

With respect to claims 14 and 40, Hiromichi teaches a computer 1 as an interface. It is inherent that computers have displays for displaying the state of the

Art Unit: 2626

printer and scanner modules. Assuming that applicant would argue, Fukushima teaches a display 100 which states the position of the camera and the information recording/production device.

Since Hiromichi and Fukushima are both directed toward image scanning and reproduction systems including a user interface, the purpose of displaying the states of the printer and scanner on a display would have been recognized by Hiromichi as set forth by Fukushima.

It would have been obvious to one of ordinary skill in the art to modify or replace computer 1 of Hiromichi so that it includes a display means for displaying the states of scanning and printing operations as set forth by Fukushima.

With respect to claim 15, Hiromichi teaches minimal cables that are represented by bi-directional arrows to and from the computer 1 and devices (2,3).

With respect to claim 16, Hiromichi shows the cable connections as claimed. For example, cables represented by the dark bold lines of figure 1 show connections between the printer module and the scanner module.

With respect to claims 17 and 25, Fukushima teaches a display 100 which comprises a bit map display from the bit map stored in video memory 101. Claims 17

and 25 are rejected for all the reasons that claims 12 and 14 are rejected in addition to the bit map display feature that would have been recognized to be incorporated in computer 1 of Hiromichi as suggested by Fukushima.

With respect to claim 18, Hiromichi teaches the first and second frames as clearly shown by figure 1.

With respect to claim 19, Hiromichi teaches first and second separate structures, as shown by figure 1.

With respect to claim 20, commercial power is inherent in its utilization for the functionality of the modules 2 and 3.

With respect to claim 28, the key pad 105 and the display unit 100 are taught by Fukushima although although it is somewhat inherent by computer 1 of Hiromichi.

Hiromichi teaches a computer 1 as an interface. It is inherent that computers have displays for displaying the state of the printer and scanner modules. Assuming that applicant would argue, Fukushima teaches a display 100 which states the position of the camera and the information recording/production device.

Since Hiromichi and Fukushima are both directed toward image scanning and reproduction systems including a user interface, the purpose of displaying the states of the printer and scanner on a display would have been recognized by Hiromichi as set forth by Fukushima.

It would have been obvious to one of ordinary skill in the art to modify or replace computer 1 of Hiromichi so that it includes a display means for displaying the states of scanning and printing operations as set forth by Fukushima.

With respect to claim 32, Hiromichi teaches a computer 1 as an interface. It is inherent that computers have displays for displaying the state of the printer and scanner modules. Assuming that applicant would argue, Fukushima teaches a display 100 which states the position of the camera and the information recording/production device.

Since Hiromichi and Fukushima are both directed toward image scanning and reproduction systems including a user interface, the purpose of displaying the states of the printer and scanner on a display would have been recognized by Hiromichi as set forth by Fukushima.

It would have been obvious to one of ordinary skill in the art to modify or replace computer 1 of Hiromichi so that it includes a display means for displaying the states of scanning and printing operations as set forth by Fukushima.

With respect to claim 33, Hiromichi teaches minimal cables that are represented by bi-directional arrows to and from the computer 1 and devices (2,3).

With respect to claim 34, Hiromichi teaches the connections are inherent according to figure 1. Power is supplied to both the scanner and the printer from power

source 4. The input of the power source is inherently commercial power obtained from a wall.

With respect to claim 35, Fukushima teaches a display 100 which comprises a bit map display from the bit map stored in video memory 101. Claim 35 is rejected for all the reasons that claim 32 is rejected in addition to the bit map display feature that would have been recognized to be incorporated in computer 1 of Hiromichi as suggested by Fukushima.

With respect to claim 36, Hiromichi teaches the first and second frames as clearly shown by figure 1.

With respect to claim 37, Hiromichi teaches first and second separate structures, as shown by figure 1.

With respect to claim 38, commercial power is inherent in its utilization for the functionality of the modules 2 and 3.

With respect to claim 46, the key pad 105 and the display unit 100 are taught by Fukushima although although it is somewhat inherent by computer 1 of Hiromichi.

Hiromichi teaches a computer 1 as an interface. It is inherent that computers have displays for displaying the state of the printer and scanner modules. Assuming that applicant would argue, Fukushima teaches a display 100 which states the position of the camera and the information recording/production device.

Since Hiromichi and Fukushima are both directed toward image scanning and reproduction systems including a user interface, the purpose of displaying the states of the printer and scanner on a display would have been recognized by Hiromichi as set forth by Fukushima.

It would have been obvious to one of ordinary skill in the art to modify or replace computer 1 of Hiromichi so that it includes a display means for displaying the states of scanning and printing operations as set forth by Fukushima.

5. Claims 1-11, 48 and 49 are allowed for reasons set forth in the communication of May 27, 2003.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 703-305-4391. The examiner can normally be reached on Jerome Grant II from Mon.-Fri. to 9:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams, can be reached on (703) 5:00. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
JEROME GRANT II  
PRIMARY EXAMINER